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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/658,337 | 09/10/2003 | Willard C. Wacha | 19080.04 | 1868 |
| 23405 | 7590 | 01/20/2006 | EXAMINER | |
| HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203 | | | ARK, DARREN W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3643 | |

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|---------------------------|-------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/658,337 | WACHA, WILLARD C. |
| | Examiner Darren W. Ark | Art Unit 3643 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,16-25 and 27-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,16-25 and 27-38 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 November 2005 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/20/2005.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Drawings

1. The drawings (Figs. 3, 6) were received on 11/14/2005. These drawings are approved by the Examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 16, 17, 29, 32, 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Brott, II 5,216,830.

Marshall discloses a lip (11) with front (12) and back portions (portion of 11 rearward of 40), a strap (defined between 20 & 22), a first aperture (24), a second aperture (at 18), a plurality of spurs (50), and the hook attached between the first and second apertures (24 and at 18 in Figs. 7, 8), but does not disclose the hook attached to the lip by molded material encasing an end of the hook and the area between the first and second apertures. Brott, II discloses a hook (14) attached to the lip (12) by molded material (16 of lead) encasing an end of the hook and a portion of the lip which includes a first (30) and second (50) apertures (see Fig. 7). It would have been obvious to a person of ordinary skill in the art to modify the device of Marshall such that the hook is

attached to the lip by molded material encasing an end of the hook and the area between the first and second apertures in view of Brott, II in order to provide a means for permanently fixing the lip and hook together rigidly and positionally with respect to each other and also provides additional weight to the lip so as to sink more quickly and to greater depths.

In regard to claim 16, see col. 3, lines 20-31.

In regard to claim 17, Marshall and Brott, II discloses the lip made of metal but not of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lip out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because plastic can be molded in many different shapes, sizes, and configurations. *In re Leshin*, 125 USPQ 416.

In regard to claims 36 and 38, Marshall discloses the spurs constitute bait holders (bait may be placed onto the spurs; the structure of the spurs is not being particularly recited) and are distinct from the hook (the spurs 50 of Marshall are separate parts assembled together with the hook under the head of the screw or bolt 40).

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Brott, II 5,216,830 as applied to claim 1 above, and further in view of Peters et al. 3,344,549 or Lievense 2,886,914.

Marshall and Brott, II do not disclose the lip made of plastic. Peters et al. and Lievense disclose the lip (25 or 1) made out of plastic (transparent or translucent plastic). It would have been obvious to a person of ordinary skill in the art to make the lip of Marshall and Brott, II such that it is made out of transparent or translucent plastic in view of Peters et al. or Lievense in order to provide a lip which is difficult to be seen by the fish.

5. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Brott, II 5,216,830 as applied to claim 1 above, and further in view of Wicht 5,588,247.

Marshall and Brott, II do not disclose the molded material being one of a non-toxic metal or a polymer. Wicht discloses the body (10), body extension (11), and cap (24) being formed from a non-toxic metal (lead-free brass) because of environmental concerns. It would have been obvious to a person of ordinary skill in the art to make the molded material of Marshall and Brott, II out of a non-toxic metal in view of Wicht in order to provide a sinker material which provides the necessary mass yet will not pollute the environment if lost.

6. Claims 18-25, 27, 28, 30, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Gibbs 2,700,240.

Marshall discloses a body (11 in Figs. 7, 8) with a lip portion (portion of 11 at and forward of 40 extending to 12) with a rounded outer edge (at 12) tapering into a substantially flat, narrow elongated neck portion (portion rearward of 40; transition between the lip and neck not particularly claimed) with parallel opposed sides (flat sides

are parallel); a first aperture (at 18); means for receiving a line (22) comprising a punched out strap (22 along with forward edge of 20 defines a narrow area that is a strap) protruding from the lip (the narrow area protrudes from the front of the lip); a second aperture (24 or 22); and means for promoting sinking when exposed to a flow of water comprised of a raised lip (concave shape of 12 defines outer edge which is raised higher relative to the rest of the surface; also weight of 40) and positioning of the lip portion such that it is non-planar with the neck portion (see Fig. 7); a plurality of spurs (50), but does not disclose the rounded outer edge tapering to substantially parallel opposed lateral sides of the narrow elongated neck portion. Gibbs discloses a rounded outer edge (outer edge of 1) tapering to substantially parallel opposed lateral sides of the narrow elongated neck portion (parallel sides of 6). It would have been obvious to a person of ordinary skill in the art to modify the rounded outer edge of Marshall such that it tapers to substantially parallel opposed lateral sides of the narrow elongated neck portion in view of Gibbs in order to provide a neck portion which looks gives the appearance of a body portion of a baitfish.

In regard to claims 30 and 31, Marshall discloses the spurs comprise bendable wire (wire-like weedguards 52, 54) and are adapted to retain one of a second hook and bait (the spurs 52, 54 are capable of retaining one of a hook and bait since they have the necessary structure to have a hook or bait secured thereto; the spurs are not being particularly claimed).

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Gibbs 2,700,240 as applied to claim 18 above, and further in view of Perry 2,538,703.

Alternatively, Marshall and Gibbs do not disclose a punched out strap. Perry discloses a punched out strap (rib 26). It would have been obvious to a person of ordinary skill in the art to modify the means for receiving a line of Marshall and Gibbs such that it is in the form of a punched out strap in view of Perry in order to provide a means for receiving the line which extends outwardly from the surface of the lip so it is positioned to facilitate threading the line for engagement therewith.

Response to Arguments

In regard to applicant's argument that "...devices disclosed by Marshall are not sinkers, but lures...", the Examiner contends that the devices disclosed by Marshall are do indeed sink since the lures were not disclosed as having any sort of buoyancy or capability of floating. Furthermore, the claims do not particularly recite the desired invention in such a manner which overcomes the lures disclosed by Marshall.

In regard to applicant's argument that "...'weedguard 50' of Marshall are not spurs...but simply wires...'are adapted to retain one of a second hook and bait'...", the Examiner contends that the spurs have not been recited in the claims in a manner which overcomes the interpretation of the Marshall weedguard 50 as comprising spurs which applicant further recites in claim 30 as comprising bendable wire which is the same material that the spurs of Marshall are made from. The weedguard 50 of Marshall

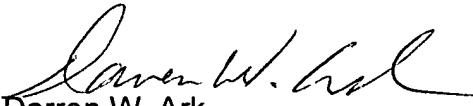
has the necessary minimum structure which will allow it to receive a hook or bait thereon.

In regard to applicant's argument that "Marshall does not include a 'punched out strap'... ", the Examiner contends that the strap of Marshall between the eyelet 22 and outer edge of the lip has two ends attached to the lip as recited by applicant in the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (571) 272-6885. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Darren W. Ark
Primary Examiner
Art Unit 3643

DWA